

### **REMARKS/ARGUMENTS**

Reexamination and reconsideration of this application, withdrawal of the rejection, and formal notification of the allowability of all claims as now presented are earnestly solicited in light of the remarks that follow. Claims 1, 3, 4, 8-16 and 18-27 are pending in the application. Applicants note with appreciation that the Examiner has indicated that Claim 27 is allowed and that Claims 15, 16 and 23 would be allowable if rewritten in independent form.

Claims 1, 3, 4, 8-14, 18-22 and 24-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,174,720 to Hall in view of U.S. Patent No. 7,115,085 to Deal. The Examiner relies upon the Hall reference as disclosing a cigarette filter comprising an adsorbent and relies upon the Deal reference as suggesting that breakable capsules can be placed in filter elements. Applicants respectfully traverse this rejection.

As previously noted, the filter element of the invention comprises an adsorbent material and at least one breakable capsule positioned in a section of filter material distal from the tobacco rod and downstream from the adsorbent material. Thus, as embodied in claim 1, the claimed filter comprises a first longitudinally extending section of filter material positioned at the end of the filter element distal from the tobacco rod, a breakable capsule within that section of filter material, and an adsorbent material positioned between the first section of filter material and the tobacco rod. As noted in the specification, it has been determined that positioning the breakable capsule downstream from the adsorbent material allows a smoker to selectively adjust the flavor of the cigarette and, in particular, alter any negative flavor attributes caused by the presence of the adsorbent. Such a filter configuration is neither taught nor suggested in the cited references.

It is respectfully submitted that the references now relied upon by the Examiner provide only very general teachings and certainly fail to describe the specific filter element configuration as presently claimed. The Hall reference merely discloses a well-known filter configuration commonly referred to as a "plug/space/plug" configuration wherein the space between the two

filter sections, or “plugs,” contains an adsorbent material. As noted by the Examiner, the Hall reference is silent as to the presence of any sort of capsule in the filter element.

The Examiner relies upon the Deal reference as allegedly overcoming the deficiency of the Hall reference, but it is noted that the Deal patent provides no guidance as to where to place a breakable capsule in relation to an adsorbent material. In fact, the Deal patent does not disclose any filter configurations comprising both an adsorbent material and a breakable capsule of any sort. The section of column 2 of the Deal patent relied upon by the Examiner merely lists various patent references that disclose filter elements comprising capsules. It is noted that all the references listed in column 2 of the Deal patent have been separately considered by the Examiner during prosecution of this application. In fact, two of the patents listed in column 2 of the Deal patent have already been cited by the Examiner and overcome during prosecution of this application. Specifically, the Examiner has previously cited U.S. Patent No. 4,889,144 to Tateno *et al.* and U.S. Patent No. 3,635,226 to Horseywell *et al.* as references disclosing the use of breakable capsules in a filter element.

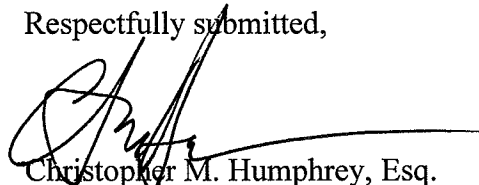
However, as previously argued by Applicants, neither the Tateno nor the Horseywell reference suggest a filter configuration as specifically claimed herein. In particular, it is noted that the Tateno reference suggests combining an adsorbent material and breakable capsules within a central cavity of a filter element. The Horseywell reference fails to suggest the use of two sections of filter material defining a compartment therebetween. It is noted that all rejections based on these two references were previously overcome. However, the Examiner now presents a reference, the Deal patent, which does not describe any particular filter configurations comprising a breakable capsule but merely refers to a number of patent documents that describe various uses of breakable capsules, including patents previously cited by the Examiner and overcome by Applicants during prosecution of the present application. Applicants respectfully submit that the much more general teachings of the Deal patent, which admittedly must rely on the disclosure of other patents of record already considered by the Examiner, cannot be viewed as supportive of an obviousness rejection of the present claims.

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In contrast to the teachings of the cited art, the present inventions derived from the understanding that the relative position of adsorbent particles and a flavor-generating breakable capsule is important. As noted in all claims, the adsorbent material must be located between the breakable capsule and the tobacco rod such that the breakable capsule can modify any negative sensory characteristics associated with the presence of the adsorbent due to its positioning downstream from the adsorbent material. Such a configuration is clearly neither taught nor suggested in any of the references cited by the Examiner. If anything, the only suggestion is to combine the adsorbent and the flavor capsules in the same central cavity as shown in the Tateno reference cited in the Deal patent. In light of the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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